REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed December 29, 2003 (the "Office Action"). The Examiner rejects Claims 1-41 and 43-57. Applicant adds new Claims 58 and 59 herein. Applicant respectfully requests reconsideration and favorable action in this case.

Consideration of Information Disclosure Statements

Applicant submitted Information Disclosure Statements (the "IDSs") with references on January 16, 2002 and December 5, 2003. There is no indication that the references submitted with these Information Disclosure Statements were considered. Therefore, Applicant respectfully requests consideration by the Examiner of the submitted references, and in the event a patent issues on this Application, that this art be printed on the face of the issued patent. Furthermore, Applicant respectfully requests copies of the PTO Form 1449 forms for each of these Information Disclosure Statements indicating the Examiner's consideration of the references.

Telephone Conference

Applicant, specifically Chad C. Walters (Reg. No. 48,022), discussed Claim 1 with Examiner Anand P. Bhatnagar and Supervisory Examiner Au on March 1, 2004 via telephone conference. No agreement with respect to Claim 1 was reached in the telephone conference. Applicant appreciates the Examiner's willingness to discuss pending claims of the present Application.

Section 112 Rejections

The Office Action rejects Claims 56 and 57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection for the reasons discussed below.

The Office Action states that the element "'the MICR buffer data comprising a format incompatible with the check processing system' is not found anywhere in the original specifications as filed. Nowhere in the specifications does it described that any data obtained

is incompatible with the processing system." However, when describing a particular embodiment, the specification states:

> The API 40 converts the MICR buffer 32 into a standardized process buffer 50 by reformatting the MICR data into a format that may be processed by the check processing system 16. The process buffer 50 is standardized in that the format of the process buffer 50 is the same regardless of the format of the MICR buffer 32 for the sorter 14.

Specification, page 9, line 29 - page 10, line 4. Thus, the specification discusses reformatting MICR data into a standardized process buffer of a format that may be processed by the check processing system. The change in format to a format that may be processed by the check processing system indicates that the original format of the MICR data, before reformatting, could not be processed by the system. Thus, the original format of the MICR buffer data is incompatible with the check processing system in a particular embodiment. Thus, Applicant respectfully submits that Applicant's original disclosure as filed supports the element "the MICR buffer data comprising a format incompatible with the check processing system."

Section 102 Rejections

The Office Action rejects Claims 1, 2, 4, 8, 11, 13, 17, 20, 21, 23, 27, 32, 34, 38, 42, 44 and 48 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,370,266 to Lau et al. ("*Lau*").

To anticipate a claim, each and every limitation must be found in a reference. In addition, the identical invention must be shown in as complete detail as is contained in the claims and the elements must be arranged as required by the claim. *See Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *see In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); *see* MPEP § 2131.

Claim 1 recites "process buffer data standardized for a plurality of disparate types of check sorters." Claims 11, 20, 31 and 41 include similar elements. The Office Action asserts that *Lau* discloses this element because *Lau* discloses multiple application programs "where each program is specific for a specific transport hardware configuration and/or MICR reader sorter." *See* Office Action, page 6. The Office Action states that the "different application programs in the memory 'process buffer' is read as the process buffer being standardized for a

plurality of types of check sorters." *See id.* However, the Office Action's assertion, on which the rejection is based, that the multiple application programs of *Lau* are specific for specific MICR reader sorters is incorrect. *Lau* discloses different transport application programs 56 that are each associated with a particular type of document processing work, such as proof of deposit, remittance processing and sorting of items. *See Lau*, col. 4, lines 23-29. Nowhere does *Lau* indicate that each application program 56 is specific for a specific transport hardware configuration and/or MICR reader sorter, as the Office Action contends. Applicant thus respectfully submits that *Lau* does not disclose, teach or suggest process buffer data standardized for a plurality of disparate types of check sorters.

Claim 1 also recites "MICR buffer data comprising MICR data retrieved from a check." Claims 11, 20, 31 and 41 include similar elements. The Office Action asserts that transport configuration database 66 of *Lau* is an MICR buffer. *See* Office Action, page 5, third paragraph. However, in actuality transport configuration database 66 includes a transport device knowledge database (TDKB) and a number of different transport configuration sets of parameters. *See Lau*, col. 5, lines 5-8. The TDKB contains zone information rules. *See id.*, col. 5, lines 8-9. The transport configuration sets of parameters contain device-related parameters for devices which may be used in transport 12, transport-related parameters for types of transports 12 and general document processing requirements for different types of documents to be processed by transport 12. *See id.*, col. 5, lines 10-20. Nowhere does *Lau* indicate that transport configuration database 66 is an MICR buffer or includes MICR data retrieved from a check, as the Office Action contends and requires for its rejection.

Claim 1 additionally recites "generating process buffer data based on the MICR data." Claims 11, 20, 31 and 41 include similar elements. The Office Action suggests that memory unit 52 of *Lau* is a "process buffer" that accesses transport database 66 through control program 60 and "generates data which is stored inside the control program." Office Action, page 5, third paragraph. The Office Action states that "[t]his newly created data stored in the control program is read as the 'process buffer data' and the process of taking the data from the transport database and putting it into the item control memory is seen as generating process buffer data." Office Action, pages 5-6. However, *Lau* actually discloses that control

program 60 of memory 52 processes data from transport configuration database 66 to provide control data for a selected transport application program 56 to control transport 12 and devices along transport path 14. *See Lau*, col. 4, lines 51-57. As indicated above, transport configuration database 66 does not even include MICR data. Thus, the disclosure in *Lau* of control program 60 processing data from transport configuration database 66 does not provide the required disclosure of generating process buffer data based on MICR data, as contended by the Office Action. Moreover, *Lau* does not disclose, teach or suggest this element.

Applicant notes that *Lau* discloses an item control memory 72 which stores MICR codelines. *See Lau*, col. 4, line 58 - col. 5, line 4. However, this item control memory 72 cannot be read as the claimed MICR buffer data comprising MICR data retrieved from a check. As indicated above, the claims recite "generating process buffer data based on the MICR data" or a similar element. Thus, to support a proper rejection, *Lau* would at least have to disclose generating process buffer data based on MICR data from its item control memory 72. However, the Examiner has not cited any portion of *Lau* as disclosing this element, nor is this element disclosed by *Lau*. Item control memory 72 of *Lau* discloses certain data, but its MICR data is not used as the basis for generated process buffer data standardized for a plurality of disparate types of check sorters.

As indicated above, to anticipate a claim, the identical invention must be shown in as complete detail as is contained in the claims, and the elements must be arranged as required by the claim. Applicant has noted multiple claimed elements not disclosed by the cited art used in the rejections. Therefore, for at least these reasons, Applicant respectfully requests allowance of Claims 1, 11, 20, 31 and 41. Moreover, since Claims 2, 4, 8, 13, 17, 21, 23, 27, 32, 34, 38, 44 and 48 each depends, either directly or indirectly, from one of independent Claims 1, 11, 20, 31 and 41, Applicants respectfully submit that Claims 2, 4, 8, 13, 17, 21, 23, 27, 32, 34, 38, 44 and 48 are allowable over the cited art used in the rejections and request allowance of Claims 2, 4, 8, 13, 17, 21, 23, 27, 32, 34, 38, 44 and 48.

Section 103 Rejections

The Office Action rejects Claims 3, 5-7, 9, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47, 49, and 50-55 under 35 U.S.C. § 103(a) as being unpatentable over *Lau* and U.S. Patent No. 5,790,260 to Myers ("*Myers*").

As discussed above, *Lau* fails to teach all elements of independent Claims 1, 11, 20, 31 and 41 from which Claims 3, 5-7, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47 and 49 depend. And the Office Action cites no teaching of the missing elements in Myers. Accordingly, Claims 3, 5-7, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47 and 49 are allowable and Applicants respectfully request withdrawal of these rejections and full allowance of these Claims.

In regard to Claim 51, Applicants point out that neither *Lau* nor *Myers* disclose a "controller operable to control the digital imaging system to selectively image one or more of the front and the back of the check." While *Lau* teaches to image a check during check processing, and *Myers* teaches to take images of the front and back of the checks, neither of these references teach a "digital imaging system to selectively image one or more of the front and the back of the check." Rather, *Lau* teaches to capture an image of each check that is processed, and *Myers* teaches creating a microfilm image of the front and back of each item *See Lau*, col. 3, lines 54-56 and *Myers*, col. 5, lines 64-65.

Additionally, the proposed *Lau-Myers* combination is inappropriate because the proposed modification would render *Myers* unsatisfactory for its intended purpose. *Myers* describes a system where the digital imaging system is separate from the check sorter and the digitizing process is performed "off-line." *See Myers*, col. 5, lines 40-41 and col. 6, lines 38-40. A purpose of the *Myers* invention is to separate the digital imaging system from the check sorter, so as to eliminate the need to digitize the checks during the check sorting process. According to *Myers*, this results in higher quality digitized images, faster check sorting, and better post-digitization image enhancement. *See Myers*, col. 6, lines 38-51. If *Myers* were modified by combination with *Lau*, the resulting check sorter would not have an off-line digitizing camera and would therefore not serve the intended purposes of the *Myers*

invention. Accordingly, since the proposed modification would render *Myers* unsatisfactory for its intended purpose, there can be no suggestion or motivation to make the proposed *Myers-Lau* combination. *See* MPEP § 2143.01. Applicants respectfully request withdrawal of the rejection and full allowance of Claim 51.

Independent Claim 54 is allowable for reasons analogous to those discussed above with respect to Claim 51. Accordingly, Applicants respectfully request withdrawal of the rejection and full allowance of this claim.

Dependent Claims 52, 53 and 55 are allowable as depending from allowable claims 51 and 54. Accordingly, Applicants respectfully request withdrawal of the rejections and full allowance of these claims.

To address deficiencies in the proposed *Lau-Myers* combination, the Office Action indicates that Official Notice was taken regarding several claims of the current invention. Specifically, the Office Action took Official Notice of certain aspects of Claims 9, 18, 28, 39, and 49. *See* Office Action, page 11. Applicants respectfully traverse the Official Notice of the Office Action. To the extent that any rejection is based on "Official Notice," "well-known art," common knowledge or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of his position or provide an affidavit in accordance with MPEP § 2144.03 and 37 C.F.R. § 1.104.

New Claims

Applicant adds new Claims 58 and 59 which are fully supported by the original specification. No new matter has been added. Applicant respectfully submits that the cited art does not disclose, teach or suggest each element of new Claims 58 and 59.

CONCLUSIONS

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

The Commissioner is hereby authorized to charge the amount of $208.00 to cover the fees for two (2) additional independent claims to Deposit Account No. 02-0384 of Baker Botts L.L.P. Although Applicant believes no other fees are due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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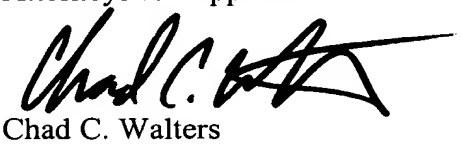

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